

## REMARKS

The present Amendment and Response is responsive to the non-final Office Action mailed June 14, 2007. Claims 1-3, 5, 11, 13-16, 18-28, 30-37 remain pending. By this Amendment, Claims 1-3, 5-11, 13-16, 18-28, and 30 have been amended, and new Claims 31-37 have been added. Independent Claim 1, and similarly independent Claims 14, and 26, have been amended to similarly recite “wherein the service provider does not transmit second bill information associated with the payee for the second payor.” Additionally, independent claims 1, 14, and 26 have been amended to shorten their respective preambles and to otherwise provide additional clarity to the claims. Dependent Claims 2, 3, 5-11, 13, 15-25, 27, 28, and 30 have generally been amended to conform to amendments made to their respective independent claims or to otherwise provide additional clarity to the claims. Applicants respectfully submit that no new matter has been added by the foregoing amendments. Reconsideration of the application, as amended, is requested.

**Independent Claims 1, 14, and 26 are allowable because a subscriber in Hogan cannot use the Hogan system to pay a payee, where a bill of the payee has not been transmitted by the Hogan system to the subscriber.**

In the non-final Office Action, independent Claims 1, 14, and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,699,528 to Hogan (hereinafter referred to as “Hogan”). In particular, the Office Action alleges that Hogan discloses that the service provider receives “a second payment instruction from another payor to pay a payee based on other than the transmitted bill information.” (Office Action, page 2).

Applicants respectfully submit that Hogan does not teach or suggest all of the features of amended independent Claims 1, 14, and 26. In summary, a subscriber in Hogan cannot use the Hogan system to pay a payee, where a bill of the payee has not been transmitted by the Hogan system to the subscriber.

Turning now to Hogan, Hogan generally discloses a bill delivery and payment system (hereinafter referred to as the “Hogan system”). In the Hogan system, the participating payees no longer mail paper bills to the subscribers of the Hogan system. (Col. 2, lines 21-23 and Col.

4, lines 53-56) (stating that “the ESBC has negotiated with selected payees participating [in the service] such that the payees no longer mail bills to the subscriber”). Rather, the payees that are a participating member of the Hogan system provide the billing data concerning the subscribers are provided to the a bill capture device (e.g., a computer) of the Hogan system (Col. 2, lines 23-25, and Col. 4, lines 54-58). The bill capture device collects and processes bill images from the participating payees after the images are created, but before they are printed, to extract the billing data. (Col. 4, lines 64-67). Subscribers may begin the bill payment process by logging onto a website of the Hogan system. (Col. 5, lines 62 – Col. 6, lines 13). After logging onto the website, the subscriber can select choice 203 shown in FIG. 3 corresponding to “Receive and Pay Bills.” (Col. 6, line 14 and FIG. 3). If the subscriber selects the “Receive and Pay Bills” choice 203, the subscriber’s display shows an image of the first bill (or a listing of all unpaid bills) of a participating payee. (Col. 6, lines 21-23). After viewing the image of an unpaid bill, the subscriber can specify payment options, including the pay date, payment method, and amount. (Col. 6, lines 31-33). In addition, the subscriber can also add new payees by selecting the “Select New Payees” Choice 205 in FIG. 3 (Col. 7, lines 58). Once a participating payee has been added by the subscriber, that added payee no longer provides paper bills to the subscriber, but instead provides the billing data directly to the bill capture device of the Hogan system for transmission to the subscriber. (Col. 4, lines 55-58 and Col. 7, lines 63-65).

Amended independent Claim 1, and similarly amended independent Claims 14 and 26, now recite that the service provider receives a “second payment instruction from a second payor to pay a payee, wherein the service provider does not transmit second bill information associated with the payee for the second payor.” This feature allows a second payor to provide a payment instruction to the service provider to pay a payee, where the second payor does not receive transmitted bill information associated with the payee from the service provider. For example, as described in the specification of the present application and in block 570 of FIG. 4 in accordance with an example embodiment, such a feature may allow payors to make payments electronically through the CF station 140 based upon hardcopy bills received directly from the billers, which can include a paper boy, babysitter, lawnboy, etc. (Specification, page 32, para. [0103] and block 570 of FIG. 4).

By contrast, the Hogan system does not teach or suggest that a service provider receives a “second payment instruction from a second payor to pay a payee, wherein the service provider

does not transmit second bill information associated with the payee for the second payor,” as recited in independent Claim 1, and similarly in independent Claims 14, and 26. In particular, the Hogan system does not allow a subscriber to pay a payee, where a bill of the payee has not been transmitted by the Hogan system to the subscriber. In contrast to Claims 1, 14, and 26, subscribers must actually view and receive the bills from the Hogan system prior to being able to pay them. (See “Receive and Pay bills” 203 and the discussion of how a bill is presented along with the payment options in col. 6, lines 21-45). Accordingly, the Hogan system does not teach or suggest that a service provider receives a “second payment instruction from a second payor to pay a payee, wherein the service provider does not transmit second bill information associated with the payee for the second payor,” as recited in independent Claim 1, and similarly in independent Claims 14, and 26. Therefore, Claims 1, 14, and 26 are allowable over Hogan.

As all of the dependent claims depend from an allowable independent claim, they are likewise allowable as a matter of law, notwithstanding their independent recitation of patentable features.

#### **Applicants Traverse the Office Action’s Taking of Official Notice**

The Office Action took Official Notice for Claims 2-4, 15-17, 27-29 that “it is old and well known to determine risk in order to determine what payment type to accept from a person” based upon the example “that if a customer has given bad checks in the past then check payments will not be accepted from that customer in order to avoid future losses.” (Office Action, page 4). With respect to Claims 9, 11, 13, 22, 24, the Office Action took Official Notice that “it is old and well known in bill payments and the like to consolidate various payments into one low monthly payment in order to provide convenience.” (Office Action, page 4). Applicants traverse the Office Action’s taking of Official Notice for Claims 2-4, 9, 11, 13, 15-17, 22, 24, and 27-29.

Applicants respectfully submit that MPEP §2144.03 cautions that “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to common knowledge in the art are capable of instant and unquestionable demonstration as well-known.” (emphasis added). Similarly, “[i]f Official Notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.” (MPEP

§2144.03(B)). In particular, “[t]he examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.” (Id.). Applicants respectfully submit that the Office Action has not provided such specific factual findings in support of the taking of Official Notice for Claims 2-4, 15-17, and 27-29.

With respect to the Official Notice for dependent Claims 2-4, 15-17, and 27-29, the Official Notice provides an example that “if a customer has given back checks in the past then check payments will not be accepted from that customer...” However, Applicants respectfully submit that this example does not teach or suggest the feature of a service provider automatically selecting a debit type based upon the determined risk, as recited in Claims 2, 15, and 27. For at least these foregoing reasons, Applicants respectfully traverse the taking of Official Notice for dependent Claims 2-4, 15-17, and 27-29 based upon the example “that if a customer has given bad checks in the past then check payments will not be accepted from that customer in order to avoid future losses.”

Likewise, with respect to the Official Notice of dependent Claims 9, 11, 13, 22, and 24, Applicants respectfully submit that alleged consolidation of “various payments into one low monthly payment in order to provide convenience” does not teach or suggest the consolidation recited in the aforementioned dependent claims. More specifically, the Office Action cites an example of a consolidation situation where a consumer can combine loans into a single loan in order to reduce the monthly payment. By contrast, the dependent claims may allow payments from a plurality of payors for a payee to be combined into a single payment to that particular payee. In this situation, for example, the service provider can provide only a single consolidated payment to the payee behalf of the first and second payors instead of providing two payments to the payee—one for the first payor and one for the second payor. Accordingly, Applicants respectfully traverse the taking of Official Notice for dependent Claims 9, 11, 13, 22, and 24.

## CONCLUSION

It is not believed that extensions of time or fees for addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

Respectfully submitted,



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